

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Christopher P. Bergh et al.	Art Unit	: 3622
Serial No.	: 09/777,614	Examiner	: Raquel Alvarez
Filed	: February 5, 2001	Conf. No.	: 6722
Title	: OFFER DELIVERY SYSTEM		

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APPEAL BRIEF ON BEHALF OF CHRISTOPHER P. BERGH ET AL.

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(1) Real Party in Interest

The real party in interest in the above application is Unica Corporation which was recently acquired by IBM Corporation.

(2) Related Appeals and Interferences

Appellant is not aware of any appeals or interferences related to the above-identified patent application. However, co-pending application 09/777,614 contains a common description as the present application and is currently on appeal to the Board. (Not docketed).

(3) Status of Claims

This is an appeal from the decision of the Examiner in a Final Office Action dated August 4, 2011, finally rejecting claims 17-29, 31-38 and 44-50, all the claims in the application. The claims have been twice rejected.

Claims 17-29, 31-38 and 44-50 are the subject of this appeal.

(4) Status of Amendments

All amendments have been entered. A Notice of Appeal accompanies this Brief.

(5) Summary of Claimed Subject Matter

Claim 17

Claim 17 is directed to a computer implemented method for managing and distributing offers. *“Referring to FIG. 2, the logical modules of offer management system 100 are hosted on a computer system 200, which generally includes a number of distributed server and client computers.”*¹

The inventive features of claim 1 include producing a plurality of marketing campaigns *“As illustrated in FIG. 1, the system can include multiple design components 120, each of which passes campaigns through a common delivery component 125 associated with the population of*

¹ Specification page 8, lines 11-13.

customers 110.”² each comprising a plurality of offers selected from a set of offers to send to multiple targeted individuals “*Offer broker 610 uses a rule-based engine to determine which offers can be sent to customers. An internal set of rules govern overall operation of the broker.*”³

The inventive features of claim 1 also include selecting by the one or more computers the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of such offers specified by offer data processing rules, executed by the one or more computers, from which one or more of the offers are identified for targeting specific individuals “*Delivery component 125 is responsible for selecting (e.g., filtering) and timing delivery of (e.g., prioritizing and limiting the frequency) of offers to appropriate customers 110 based on the campaigns it receives from design components 120.*”⁴

The inventive features of claim 1 also include delivering the offers over channels to specific, targeted individuals of the multiple targeted individuals, “*Offer management system 100 supports delivery of offers to customers 110 through a wide variety of channels 140*”⁵ ... *In general, offers can be delivered to any particular customer 110 through multiple of these channels.*”⁶ with the channels and time of delivery of the offers based on execution of time based rules “*Lifecycle 310 specifies time-based rules that affect how related offers are sent to a customer*”⁷ and the allocation of the offers to the channels “*Referring to FIG. 6, delivery component 125 receives campaigns from design components 120. From these campaigns, delivery component 125 forms offers that it passes them to various channels 140.*”⁸ based on the determined allocations in each of the marketing campaigns with the channels being one of a plurality of different types of delivery channels. “*Third, offer broker 610 allocates capacity for the various channels over which offers are presented to customers. Offer broker 610 selects the delivery engine 630 to which it sends offers based on the channels associated with those offers.*”⁹

² Specification page 5, lines 20

³ *Id.*, page 15 lines 6-8.

⁴ *Id.*, page 6, lines 6-8.

⁵ *Id.*, page 5, lines 1

⁶ *Id.*, page 5, lines 1-9.

⁷ *Id.*, page 12, line 25

⁸ *Id.*, page 14, line 9.

⁹ *Id.*, page 15, line 15.

Claim 31

Claim 31 is directed to an offer management system comprising a computer system comprising a processor and memory. *“Referring to FIG. 2, the logical modules of offer management system 100 are hosted on a computer system 200, which generally includes a number of distributed server and client computers.”*¹⁰ a computer-readable media storing a computer program product comprising instructions executed in memory and causing the processor to *“The software for controlling these computers is stored on media (not shown), such as magnetic disks coupled to server and client computers.”*

The inventive features of claim 31 include instructions to produce a plurality of marketing campaigns *“As illustrated in FIG. 1, the system can include multiple design components 120, each of which passes campaigns through a common delivery component 125 associated with the population of customers 110.”*¹¹ each comprising a plurality of offers selected from a set of offers to send to multiple targeted individuals *“Offer broker 610 uses a rule-based engine to determine which offers can be sent to customers. An internal set of rules govern overall operation of the broker.”*¹²

The inventive features of claim 31 also include instructions to select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers specified by templates and/or rules from which one or more of the offers are identified for targeting specific individuals *“Delivery component 125 is responsible for selecting (e.g., filtering) and timing delivery of (e.g., prioritizing and limiting the frequency) of offers to appropriate customers 110 based on the campaigns it receives from design components 120.”*¹³

The inventive features of claim 31 also include instructions to cause a delivery of the offers over channels to specific, targeted individuals of the multiple targeted individuals, *“Offer management system 100 supports delivery of offers to customers 110 through a wide variety of channels 140”*¹⁴ ... In general, offers can be delivered to any particular customer 110 through

¹⁰ Specification page 8, lines 11-13.

¹¹ *Id.*, page 5, lines 20

¹² *Id.*, page 15 lines 6-8.

¹³ *Id.*, page 6, lines 6-8.

¹⁴ *Id.*, page 5, lines 1

*multiple of these channels.*¹⁵ with the channels and time of delivery of the offers based on execution of time based rules *"Lifecycle 310 specifies time-based rules that affect how related offers are sent to a customer"*¹⁶ and the allocation of the offers to the channels *"Referring to FIG. 6, delivery component 125 receives campaigns from design components 120. From these campaigns, delivery component 125 forms offers that it passes them to various channels 140."*¹⁷ based on the determined allocations in each of the marketing campaigns with the channels being one of a plurality of different types of delivery channels. *"Third, offer broker 610 allocates capacity for the various channels over which offers are presented to customers. Offer broker 610 selects the delivery engine 630 to which it sends offers based on the channels associated with those offers."*¹⁸

Claim 33

Claim 33 is directed to a computer program product stored on computer-readable media comprising instructions. *"The logical components include modules that are implemented by software-controlled processes executing on these computers, and include storage modules, provided, for example, by storage devices coupled to the computers or by a dedicated database server computers. The software for controlling these computers is stored on media (not shown), such as magnetic disks coupled to server and client computers"*

Inventive features of claim 33 includes instructions to produce a plurality of marketing campaigns *"As illustrated in FIG. 1, the system can include multiple design components 120, each of which passes campaigns through a common delivery component 125 associated with the population of customers 110."*¹⁹ each comprising a plurality of offers selected from a set of offers to send to multiple targeted individuals *"Offer broker 610 uses a rule-based engine to determine which offers can be sent to customers. An internal set of rules govern overall operation of the broker."*²⁰

¹⁵ Specification page 5, lines 1-9.

¹⁶ *Id.*, page 12, line 25

¹⁷ *Id.*, page 14, line 9.

¹⁸ *Id.*, page 15, line 15.

¹⁹ *Id.*, page 5, lines 20

²⁰ *Id.*, page 15 lines 6-8.

The inventive features of claim 33 also include instructions to select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers specified by templates and/or rules from which one or more of the offers are identified for targeting specific individuals. *"Delivery component 125 is responsible for selecting (e.g., filtering) and timing delivery of (e.g., prioritizing and limiting the frequency) of offers to appropriate customers 110 based on the campaigns it receives from design components 120."*²¹

Inventive features of claim 33 also include instructions to cause a delivery of the offers over channels to specific, targeted individuals of the multiple targeted individuals, *"Offer management system 100 supports delivery of offers to customers 110 through a wide variety of channels 140"*²² ... *In general, offers can be delivered to any particular customer 110 through multiple of these channels."*²³ with the channels and time of delivery of the offers based on execution of time based rules *"Lifecycle 310 specifies time-based rules that affect how related offers are sent to a customer"*²⁴ and the allocation of the offers to the channels *"Referring to FIG. 6, delivery component 125 receives campaigns from design components 120. From these campaigns, delivery component 125 forms offers that it passes them to various channels 140."*²⁵ based on the determined allocations in each of the marketing campaigns with the channels being one of a plurality of different types of delivery channels. *"Third, offer broker 610 allocates capacity for the various channels over which offers are presented to customers. Offer broker 610 selects the delivery engine 630 to which it sends offers based on the channels associated with those offers."*²⁶

²¹ Specification page 6, lines 6-8.

²² *Id.*, page 5, lines 1

²³ *Id.*, page 5, lines 1-9.

²⁴ *Id.*, page 12, line 25

²⁵ *Id.*, page 14, line 9.

²⁶ *Id.*, page 15, line 15.

(6) The Ground of Rejection to be Reviewed on Appeal²⁷

Claims 17-29, 31-38 and 44-46, 48-50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benthin et al. 2002/0035568 in view of Langseth et al. US Pat. 6,694,316 and Official Notice.

(7) Argument

Claim Interpretation

It is an axiom of patent law that claim terms are not interpreted in a vacuum, devoid of the context of the claim as a whole.²⁸ In *Hockerson-Halberstadt, Inc. v. Converse Inc.*, the Federal Circuit stated that “proper claim construction ... demands interpretation of the entire claim in context, not a single element in isolation.”²⁹ Additionally, in *ACTV, Inc. v. Walt Disney Co.*, the Federal Circuit mandated that “[w]hile certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered”

Obviousness

“It is well established that the burden is on the PTO to establish a prima facie showing of obviousness, *In re Fritsch*, 972 F.2d. 1260, 23 U.S.P.Q.2d 1780 (C.C.P.A., 1972).”

In *KSR Intl. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court reversed a decision by the Court of Appeal's for the Federal Circuit decision that reversed a summary judgment of obviousness on the ground that the district court had not adequately identified a motivation to combine two prior art references. The invention was a combination of a prior art repositionable gas pedal, with prior art electronic (rather than mechanical cable) gas pedal position sensing. The Court first rejected the “rigid” teaching suggestion motivation (TSM) requirement applied by the Federal Circuit, since the Court's obviousness decisions had all

²⁷ In the prior action, the examiner also rejected the claims under obvious-type double patenting over co-pending application 09/777,614. While, the examiner has not repeated that rejection in the action being appealed from, the examiner has not given the disposition of that prior rejection. Clarification is requested.

²⁸ See *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999).

²⁹ *Id.*

advocated a "flexible" and "functional" approach that cautioned against "granting a patent based on the combination of elements found in the prior art."

In *KSR* the Supreme Court even while stating that: "the Court of Appeals drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias," warned that: "a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."

The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U. S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.

With respect to the genesis of the TSM requirement, the Court noted that although "As is clear from cases such as *Adams*³⁰, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be so

³⁰ *United States v. Adams*, 383 U. S. 39, 40 (1966)

modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

**Claims 17-29, 31-38 and 44-46, 48-50 are
patentable over Benthin in view of Langseth.**

Claims 17, 31 and 33

For the purposes of this appeal only, claims 17, 31 and 33 stand or fall together. Claim 33 is representative of this group of claims.

Claim 33 is directed to a computer program product and includes instructions to: "... select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers ..." and "cause a delivery of the offers over channels ... with the channels and time of delivery of the offers based on ... the determined allocations in each of the marketing campaigns with the channels being ... different types of delivery channels."

Benthin does not teach multiple marketing campaigns.

The examiner relies on Benthin for the feature of multiple marketing campaigns, stating that Benthin teaches: “**(Producing a plurality of marketing campaign each comprising a plurality of offers selected from a set of offers to send to multiple targeted individuals.**” Appellant contends that this feature was not properly construed by the examiner. The claim requires instructions to produce plural marketing campaigns. Benthin, in contrast, does not describe instructions to produce multiple campaigns, and thus does not recognize the attendant problem of allocating offers from multiple campaigns.³¹

Benthin does not teach any allocation of offers across multiple marketing campaigns.

Claim 33 also requires instructions to: “select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers” The examiner equates the instructions to select as recited in Claim 33 to controlling presentation of offers to customers arguing: “(I.e. **controlling the presentation of when and what type of offers to transmit to the customers, paragraphs 0031 and 0041 teaches automatic offers that are presented right away; paragraph 0030 teaches presenting the offers if it fit the customer profile and paragraph 0024 teaches the customer clicking on ads to determine which campaign of offers to present to the customer**)(see also Figure 1).” However, while these purported teachings from Benthin deal with timing of offers, which Appellant does not concede, are addressed by Benthin, in any event do not suggest instructions to select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers.

The examiner relies on Langseth, and in essence concedes that Benthin does not teach instructions to “select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers”

³¹ See Appellant's specification, p. 5, lns. 18-21.

Multiple users 115 are typically involved in the task of specifying different campaigns. In this embodiment, these users can work independently of one another, potentially generating offers that can be targeted to the same individuals.

Langseth does not cure the deficiencies in Benthin.

Regarding Langseth, the examiner states: “**Langseth teaches selecting the advertisements or offers based on the capability of the channels to the selected offers.**”³² Langseth neither describes nor would render obvious instructions to: “... select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers ...” and “cause a delivery of the offers ... to specific, targeted individuals ... with ... delivery ... based on execution of offer data processing rules and the allocation of the offers ... with the channels being ... different types of delivery channels.”

In Claim 33, allocation of offers to channels is based on “... the determined allocations in each of the marketing campaigns” Appellant contends that Benthin combined with Langseth would neither describe nor render obvious allocation of offers produced from marketing campaigns based on a determined channel allocation. Langseth is silent regarding a feature that resembles “a determined channel allocation of offers.”

Langseth does not possess “delivery channel types”
as that term is used by Appellant.

The examiner has not properly construed the term “channel.” Rather than construing the entire feature that includes the word “channel,” the examiner merely focuses on the word “channel.” The examiner interprets that word in a vacuum, devoid of the context of the claim as a whole in contravention to *Hockerson-Halberstadt*.³³ Properly construed, channel refers to the delivery mechanism/medium. In contrast, Langseth uses the word “channel” differently from that required by Appellant’s claims.

It is clear that one of ordinary skill would not construe “channel” as used in Langseth, as resembling “channel” and “delivery channel types” as used by Appellant. Therefore, the alleged combination of Benthin and Langseth would neither describe nor render obvious instructions to “cause a delivery of the offers over channels to specific, targeted individuals ... based on execution of offer data processing rules and the allocation of the offers to the channels based on

³² Office Action p. 3.

³³ See *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999).

the determined allocations in each of the marketing campaigns with the channels being ... different types of delivery channels.”

In Langseth, “channel” refers to the content of a broadcast stream of information over the web.³⁴ In contrast, as required by Appellant’s claim 33, “channel” refers to the medium over which offers are communicated to the targeted individuals, such as by instructions to “cause a delivery of the offers over channels” Appellant provides a specific definition of channels³⁵ that is consistent with the manner that “channels” is used by Appellant in the claims. The examiner should have been consulted Appellant’s specification in construing the claimed term and the features involving the claimed term. Had the examiner correctly construed the term “channel,” the examiner would have seen that the features involving “channel” were clearly distinguished over the alleged combination of references.

To the extent that there is any resemblance of Langseth’s use of “channel” to any of the features of claim 33, the resemblance would be in some sense to Appellant’s claimed “offer.” Both offers as used by Appellant and channels as described by Langseth involve content. While Appellant’s offers are more general and in many respects different from Langseth’s “channels,” there is a resemblance because Langseth uses channels to describe personalized messages, e.g., advertisements and content. However, Langseth’s use of “channels” neither describes nor would render obvious, when modifying Benthin, any of the functional features of claim 33 that involve Appellant’s use of the term channels, and in particular the functional limitation of instructions to “cause a delivery of the offers over channels to specific, targeted individuals ... with the channels being ... different types of delivery channels.”

³⁴ See Langseth (Col. 3, l. 13)

This invention provides a system and method for providing a plurality of channels of personal intelligence content to enable subscribers to more specifically choose the content they desire to receives. The database system may then provide a plurality of “channels” wherein each channel may comprise information and transactional data about a particular field of interest, such as business, weather, sports, news, investments, traffic, radio content, television content, and others.

³⁵ See Appellant’s specification:

[0026] Offer management system 100 supports delivery of offers to customers 110 through a wide variety of channels 140. In the discussion below, a number of these channels are specifically identified, but it should be understood that the invention is applicable to many more types of channels, some of which may not yet be commonly used. The channels include both traditional channels, such as direct postal mailings and solicitations by sales agents, as well as electronic channels, such as email and Web delivery, and could include channels such as personalized location-based delivery of advertising to handheld devices. In general, offers can be delivered to any particular customer 110 through multiple of these channels. The offer management system provide a basis of controlling the potential flood of offers any one customer might receive.

Langseth's alleged teaching of selecting advertisement placement based on channel capacity and content does not teach the claimed features.

The examiner contends that: **"Langseth teaches selecting from a plurality of channels which advertisements to place based on the channel capacity and content of the channel."** The examiner however loses sight of what Appellant has claimed. The claim requires a plurality of marketing campaigns each comprising a plurality of offers ... select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation ... and cause a delivery of the offers over channels to specific, targeted individuals ... with the channels being ... different types of delivery channels."

The examiner's contentions that: **"Selecting advertisement placement"** for a **"subject-based channel of information"**³⁶ does not describe instructions to select the offers ... according to a determined channel allocation. The examiner alleges that Langseth: **"clearly teaches in step 928, the advertisements being selected based on the channel being run or the capacity of the channel."** Appellant contends that no such teaching is present in Langseth step 928 or Langseth generally. Step 928 is described by Langseth as: **"In step 928, affiliate advertisements may be included in the service outputs."** The function of step 928 however does not resemble the features involving channel allocation.

Claims 18, 23-24 and 34

For the purposes of this appeal only, claims 18 and 34 stand or fall together. Claim 34 is representative of this group of claims.

Claim 34 is directed to a computer program product that further limits claim 33. Claim 34 includes instructions to: "determine a channel to select based at least in part on the specific, targeted individual's response to an offer." The examiner takes the position that:

Claims 18, further recite determining a channel to select based on user response to an offer and delivering targeted information to the individual based on the information. Official Notice is taken that it is old and well known in marketing to determine how well users response (sic) to ads on

³⁶ Langseth Col. 7, l. 12.

TV versus ads in the radio in order to select how the ads are going to be delivered based on the user's responses. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included determining a channel to select based on user response to an offer in order to allow the advertisers to determine the best delivery medium.

Claim 34 requires instructions to: "... determine a channel to select based at least in part on a user's response to an offer." Such instructions are not suggested much less described by the purported official notice in any combination with the cited references. Rather, this alleged official notice is of no import to the claimed subject matter. Claim 34 does not claim: **"how well users response to ads on TV versus ads in the radio in order to select how the ads are going to be delivered based on the user's responses."** Applicant's claim 34 requires that the individual's response to such offers determines in part the delivery medium. Again, the examiner confuses "channels," which as taught by the combined references, deals with content with the delivery medium as required by Appellant's claims.

Claims 19 and 35

For the purposes of this appeal only, claims 19 and 35 stand or fall together. Claim 35 is representative of this group of claims.

Claim 35 is directed to a computer program product that further limits claim 33. Claim 35 includes instructions to: "prioritize the set of offers for the targeted individual ... and limit the number of prioritized offers using at least one privacy characteristic defined by the specific, targeted individual"

The examiner in the rejection of these claims states: **"Response to argument #3: The Examiner disagrees with Applicant because Benthin on paragraph 0024 teaches using privacy characteristics such as the user's profile to limit the offers types based on the user's profile."** Benthin describes:

[0024] FIG. 2A is a flow chart of the steps carried out by the customer when using the system of the present invention. The customer first logs in 30 the system. A campaign is then determined 32 to be presented to the customer. A first segment of a dialog is selected 34 according to the campaign chosen. The segment is customized using the customer's preferences 36 to be presented on the customer's interface. The segment is then presented 38. If the prompt contained in the segment is attractive, the customer will probably perform an action such as clicking on a link. This action will be recorded and analyzed 40. The user's action generates a

system event, which may cause further system responses This will determine the next segment of the dialog to present 42. Again, the segment will first be customized 44 and then presented 46. This process will continue until the dialog is over.”

It is apparent that a customer profile as contemplated by Benthin does not involve privacy features. It is clear from Benthin [0024] above that the reference does suggest instructions to: “limit the number of prioritized offers using at least one privacy characteristic defined by the specific, targeted individual in the form of feedback from the specific, targeted individual to prohibit or limit the frequency of various types of offers.” Rather, [0024] than being related to privacy characteristics that Benthin teaches something different **“If the prompt contained in the segment is attractive, the customer will probably perform an action such as clicking on a link. This action will be recorded and analyzed 40.”** This would not be seen by one of ordinary skill as instructions to: “limit the number of prioritized offers using at least one privacy characteristic defined by the specific, targeted individual.”

Nothing in either reference suggests a privacy characteristic defined by the targeted individual. Appellant is unaware of any teachings in either of the references or any purported official notice that would suggest using a privacy characteristic defined by the individual to prohibit or limit the frequency of various types of offers.

Claims 20 and 36

For the purposes of this appeal only, claims 20 and 36 stand or fall together. Claim 36 is representative of this group of claims.

Claim 36 further limits claim 35, and includes instructions to: “allocate the selected prioritized offers according to a capacity associated with each of the channels.” In an apparent effort to address this feature, the examiner argues under the rejection of claims 17, 31 and 33 that:

Langseth teaches selecting from a plurality of channels which advertisements to place based on the channel capacity and content of the channel. Langseth, clearly teaches in step 928, the advertisements being selected based on the channel being run or the capacity of the channel. Each channel accommodates or is capable of outputting different types of ads. For example, a golf site may only enable access to a sports channel.

Appellant disagrees. As discussed above, Langseth has a different concept of “channel,” which pertains to content. Langseth’s alleged “**advertisement placement**” neither describes nor renders obvious instructions to “allocate the selected prioritized offers according to a capacity associated with each of the channels.” In Langseth, advertisements are part of the “channel.” Langseth does not teach “channel capacity” and therefore does not suggest instructions to allocate prioritized offers according to a capacity associated with each of the channels, because Langseth does not suggest channel allocation of offers in plural marketing campaigns or with different delivery mediums/mechanisms, the meaning given to channel by Appellant.³⁷ Langseth deals with delivery of different content (channels as defined by Langseth) over one delivery medium type, i.e., “the Web.” Unlike the examiner’s reasoning regarding the teachings of Langseth, which is predicated solely on differences in content, claim 36 requires different delivery mechanisms/mediums, with Appellant denotes as “channels.”

Claims 21, 22, 37 and 38

For the purposes of this appeal only, claims 21 and 37 stand or fall together and claims 22 and 38 stand or fall together

Claims 37 and 38 are representative of these groups of claims. The examiner stated:

Claims 21-22, 37-38 further recite the capacity of the channels being related to the monetary cost of the channel. Official notice is taken that it is old and well known for monetary and operating cost being related to the capacity of the channels. For example, CNN will have a higher capacity than a local smaller channel with a smaller budget. It would have been obvious to have included the capacity of the channels being related to the monetary cost of the channel because such a modification would allow the channels to invest and better maintain the channels in order to have a higher chances (sic) of being selected.

Claim 37

Claim 37 is directed to a computer program product that defines channel capacity, as related to monetary costs associated with [of] the channels.

³⁷ Pub. App. [0026]

Claim 38

Claim 38 defines channel capacity, as related to a physical capacity of the channels. Langseth does not suggest either metric of claim 37 or claim 38 to define a capacity of a channel.

Assuming *arguendo* that this official notice is proper, the official notice is clearly irrelevant to the claimed subject matter. First, the official notice eschews how Langseth defines and uses the term ‘channels,’ and in effect amounts to a further, yet unstated modification of Langseth, by equating “channel” to a different station on television rather than “content,” as taught by Langseth.

Moreover, channel even if construed to correspond to channels on television, this construction would not meet the requirement of “different channel types,” as defined by Appellant. The claims require allocation of offers to individuals being related to monetary or physical capacity costs of the channels. The claimed allocation for each of the plurality of marketing campaigns that takes into consideration monetary and capacity costs of the channels is clearly not suggested by the references taken with the alleged official notice.

In addition, the official notice is illogical. Therefore, Appellant contests that this official notice is correct. Appellant contends that it is illogical to argue that: “... CNN **will have a higher capacity than a local smaller channel with a smaller budget,**” when the feature claimed is “channel capacity, as related to “monetary costs associated with [of] the channels” or “related to a physical capacity of the channels.”

Claims 28, 29, 32, 45 and 46

For the purposes of this appeal only, claims 28, 32 and 45 stand or fall together and claims 29 and 46 stand or fall together.

Claims 45 and 46 are representative of these groups of claims. The examiner stated:

With response to claims 28-29, 32 and 45-46, Benthin further teaches reporting the effectiveness of the plurality of offers and presenting a sequence of related offers to those individuals based on the individuals activities (i.e. tracking offers effectiveness in order to further target further offers to the individuals) (paragraphs 0082-0088)

Claim 45

Claim 45 requires the feature of instructions to: "track activities of the targeted individuals to whom the offers were targeted ..." and instructions to: "determine an effectiveness of the ... offers by matching information received from sources of activity related information to the offers."

Claim 46

Claim 46 requires instructions to: "present through channels selected from the plurality of channels a sequence of subsequent offers ... based on ... tracked activities."

The alleged combination of Benthin, Langseth and official notice neither describes nor renders obvious the features of instructions to "track ... according to the channels over which the offers were sent," as in claim 45 or instructions to "determine effectiveness by matching information received from sources of activity" or instructions to: "present subsequent offers based on tracked activity," as in claim 46. Benthin, Langseth and official notice do not teach channels as that term is used by Appellant, for reasons given above and therefore would not suggest instructions to track activities according to the channels over which the offers were sent," as in claim 45 or instructions to "present subsequent offers based on tracked activity," as in claim 46.

Claims 48-50

For the purposes of this appeal only, claims 48-50 stand or fall together. Claim 50 is representative of this group of claims.

Claim 50 requires that "... at least one of the offer data processing rules is a rule selected from a set of time based rules, and further requires that instructions to select ... select one of the offers based on execution of one of the time based rules."

With respect to claims 48-50, Benthin further teaches wherein at least one of the offer data processing rules being a set of time based rules, the time based rules including at least one of a direct rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a staged rule that instantiates offers based on user interaction with previous offers; and wherein selecting further comprises: selecting one of the offers

based on execution of one of the time based rules (Benthin clearly teaches different times to present the offers such as certain offers are presented right away, equivalent to Applicant's direct rule (i.e. specify the content to be automatically present the customer on paragraph 0031), other offers are presented based on the timing of certain conditions, such as the user clicking on certain ads, equivalent to Applicant's triggered rule (i.e. clicking on a link on paragraph 0024) and in addition certain offers presented in stages such as building a customer profile and then presenting different offers to the customers, equivalent to Appellant's staged rule (i.e. offers based on customer's profile, paragraph 0024).

Benthin neither describes nor would render obvious in any combination with Langseth, "time based rules" as an offer data processing rule. Benthin describes presenting campaigns to a customer, allowing a user to select customers based on customer profiles, and allowing a user to choose campaign content to present to a customer. In [0024], Benthin describes "steps carried out by the customer when using the system..."

None of those steps, however, are an example of an offer processing time based selection rule. In [0030], Benthin deals with user selection of products/services and customer profiles, and creation of customer groups. Again, these teachings do not suggest time based selection rules. In [0031], Benthin describes a campaign editor/creator 20 to specify content (known as dialog) in the campaign. Again, there is no suggestion of time based rules. While at [0042] Benthin describes that: "A campaign is a set of content and presentation rules used to target a promotion to a specified user group, following a specific schedule." Benthin describes that **"Dialogs are content sequencing rules. They represent a decision tree, which the customer then navigates depending on his or her choices, and on their profiles."** These are not time based selection rules.

One of ordinary skill in this art would not construe Benthin and Langseth to teach: "at least one of the offer data processing rules is a rule selected from a set of time based rules," much less the specifically claimed time based rules of "a direct rule that immediately instantiates offers based on an offer campaign," or "a triggered rule that instantiates offers based on the occurrence of particular conditions" or "a staged rule that instantiates offers based on user interaction with previous offers."

Such a construction of Benthin with Langseth is the result of *ex post* reasoning gleaned from teachings in Appellant's specification and/or claims. In *KSR* the Supreme Court even while stating that: "the Court of Appeals drew the wrong conclusion from the risk of courts and patent

examiners falling prey to hindsight bias," warned that: "a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."

The post-offer selection activities in Benthin do not resemble rules that are involved in campaign design activities, i.e., offer data processing rule, as required by claim 50. The presentation of offers in Benthin is not predicated on the existence of or execution during a marketing campaign of "time based rules." Rather, all that the examiner argues is taught by Benthin is that certain actions of a customer with respect to offers can occur at various times. The examiner's opinions however are not a substitute for the clear lack of a description of a functional equivalent in Benthin to "time based rules."

The examiner implies that Benthin's teaching of "automatically present the customer ..." ³⁸ in [0031] is equivalent to the direct rule. However, [0031] teaches: "[0031] *** A campaign may also include within its definition that it is to be activated when a customer selects a predetermined page within an HTML site. The campaign editor may be used to specify the content to be automatically presented to a customer by specifying a particular template for an HTML page presentation." ³⁹ Thus, rather than specifying a direct time-based rule "content to be automatically presented" ⁴⁰ is predicated solely on what content the campaign editor specifies to present to the customer when the customer accesses an HTML page.

Neither a user "clicking on ads" nor "building a customer profile" nor "presenting different offers to customers" resembles any of the claimed time based rules. Nothing in the design of a campaign using the teachings of Benthin has any equivalency to "offer data processing rules comprising a set of time based rules including a direct rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a staged rule that instantiates offers based on user interaction with previous offers."

Benthin fails to either describe or render obvious in combination with the cited art to execute the selected time based rules to determine the selected offers." A user "clicking on ads,"

³⁸ Answer p. 9.

³⁹ Benthin

⁴⁰ *Id.*

“building a customer profile” or “presenting different offers to customers” does not in Benthin result from execution of a time based rule to select one of the offers to send.

Conclusion

Appellant submits that Claims 17-29, 31-38 and 44-46, 48-50 are allowable over the cited art. Therefore, the Examiner erred in rejecting Appellant's claims and should be reversed.

Respectfully submitted,

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Appendix of Claims

Claims 1-16 are cancelled.

17. A computer implemented method for managing and distributing offers, the method comprising:

producing a plurality of marketing campaigns each comprising a plurality of offers selected from a set of offers to send to multiple targeted individuals;

selecting by one or more computers the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers specified by offer data processing rules, executed by the one or more computers, from which one or more of the offers are identified for targeting specific individuals; and

delivering the offers over channels to specific, targeted individuals of the multiple targeted individuals, with the channels and time of delivery of the offers based on execution of offer data processing rules and the allocation of the offers to the channels based on the determined allocations in each of the marketing campaigns with the channels being one of a plurality of different types of delivery channels.

18. The method of claim 17 further comprising:

determining a channel to select based at least in part on the specific, targeted individual's response to an offer.

19. The method of claim 17 further comprising:
prioritizing by the computer the set of offers for the targeted individual to determine which offer or offers from the set of offers should be sent to the targeted individual; and
limiting the number of prioritized offers using at least one privacy characteristic defined by the specific, targeted individual in the form of feedback from the specific, targeted individual to prohibit or limit the frequency of various types of offers.

20. The method of claim 19 wherein delivering, delivers the selected prioritized offer and the method further comprises:
allocating the selected prioritized offers according to a capacity associated with each of the channels.

21. The method of claim 20 wherein the capacity of the channels is related to monetary costs associated with of the channels.

22. The method of claim 20 wherein the capacity of the channels is related to a physical capacity of the channels.

23. The method of claim 17 further comprising:
accepting information from the specific, targeted individual and limiting selection of the offer for delivery to the specific, targeted individual according to the accepted information.

24. The method of claim 23 wherein the accepted information characterizes acceptable timing of presentation of offers to the specific, targeted individual, and limiting selection of the offer includes scheduling selection of the offer to the specific, targeted individual according to the acceptable timing.

25. The method of claim 17 wherein channels comprise direct postal mailings, solicitations by sales agents, email, Web delivery, and personalized location-based delivery of advertising to handheld devices.

26. The method of claim 17 wherein producing a marketing campaign comprises: preparing data characterizing target groups of specific, targeted individuals associated with the offers.

27. The method of claim 17 wherein producing a marketing campaign comprises: preparing data characterizing information to present with the offers.

28. The method of claim 17 further comprising:
tracking activities of the targeted individuals to whom the offers were targeted with tracking according to the channels over which the offers were sent; and
determining by the one or more computers an effectiveness of the plurality of offers by matching information received from sources of activity related information to the offers.

29. The method of claim 28 further comprising:

delivering through channels selected from the plurality of channels a sequence of

subsequent offers to individuals based on their tracked activities.

30. (Canceled)

31. An offer management system comprising:

a computer system comprising:

a processor;

memory; and

a computer-readable media storing a computer program product comprising instructions
executed in memory and causing the processor to:

produce a plurality of marketing campaigns each comprising a plurality of offers selected
from a set of offers to send to multiple targeted individuals;

select the offers to send for each of the plurality of marketing campaigns according to a
determined channel allocation of offers specified by templates and/or rules from which one or
more of the offers are identified for targeting specific individuals; and

cause a delivery of the offers over channels to specific, targeted individuals of the
multiple targeted individuals, with the channels and time of delivery of the offers based on
execution of offer data processing rules and the allocation of the offers to the channels based on
the determined allocations in each of the marketing campaigns with the channels being one of a
plurality of different types of delivery channels.

32. The offer management system of claim 31 wherein the computer program product further comprises instructions to:

track activities of the targeted individuals to whom the offers were targeted with instructions to track being according to the channels over which the offers were sent; and
determine an effectiveness of the plurality of offers by matching information received from sources of activity related information to the offers.

33. A computer program product stored on computer-readable media comprising instructions for causing a computer system to:

produce a plurality of marketing campaigns each comprising a plurality of offers selected from a set of offers to send to multiple targeted individuals;

select the offers to send for each of the plurality of marketing campaigns according to a determined channel allocation of offers specified by templates and/or rules from which one or more of the offers are identified for targeting specific individuals; and

cause a delivery of the offers over channels to specific, targeted individuals of the multiple targeted individuals, with the channels and time of delivery of the offers based on execution of offer data processing rules and the allocation of the offers to the channels based on the determined allocations in each of the marketing campaigns with the channels being one of a plurality of different types of delivery channels.

34. The computer program product of claim 33 further comprising instructions to:

determine a channel to select based at least in part on the specific, targeted individual's
response to an offer.

35. The computer program product of claim 33, further comprising instructions to:

prioritize the set of offers for the targeted individual to determine which offer or offers
from the set of offers should be sent to the targeted individual; and

limit the number of prioritized offers using at least one privacy characteristic defined by
the specific, targeted individual in the form of feedback from the specific, targeted individual to
prohibit or limit the frequency of various types of offers.

36. The computer program product of claim 35 wherein delivering the selected
prioritized offer comprises instructions to:

allocate the selected prioritized offers according to a capacity associated with each of the
channels.

37. The computer program product of claim 36 wherein the capacity of the channels
is related to monetary costs associated with of the channels.

38. The computer program product of claim 36 wherein the capacity of the channels
is related to a physical capacity of the channels.

39-43. Canceled.

44. The computer program product of claim 33 wherein instructions to produce a marketing campaign further comprises instructions to:

- determine characterizing conditions under which the offers are delivered;
- determine which individuals associated with particular ones of the offers based at least in part on profiles of each of the individuals.

45. The computer program product of claim 33, further comprising instructions to:

- track activities of the targeted individuals to whom the offers were targeted with instructions to track according to the channels over which the offers were sent; and
- determine an effectiveness of the plurality of offers by matching information received from sources of activity related information to the offers.

46. The computer program product of claim 45, further comprising instructions to:

- present through channels selected from the plurality of channels a sequence of subsequent offers to individuals based on their tracked activities.

47. (Canceled)

48. The method of claim 17 wherein at least one of the offer data processing rules is a rule selected from a set of time based rules, the time based rules including at least one of a direct

rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a staged rule that instantiates offers based on user interaction with previous offers; and wherein selecting further comprises:

selecting by the one or more computers one of the offers based on execution of one of the time based rules.

49. The system of claim 31 wherein at least one of the offer data processing rules is a rule selected from a set of time based rules, the time based rules including at least one of a direct rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a staged rule that instantiates offers based on user interaction with previous offers; and wherein instructions to select further comprises instructions to:

select one of the offers based on execution of one of the time based rules.

50. The computer program product of claim 33 wherein at least one of the offer data processing rules is a rule selected from a set of time based rules, the time based rules including at least one of a direct rule that immediately instantiates offers based on an offer campaign, a triggered rule that instantiates offers based on the occurrence of particular conditions, and a staged rule that instantiates offers based on user interaction with previous offers; and wherein instructions to select further comprises instructions to:

select one of the offers based on execution of one of the time based rules.

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Evidence Appendix

None

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Related Proceedings Appendix

None